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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Docket No. 1805-0001

Application of: Mark E. Sanders

Group Art Unit: 2210

Serial No. 10/039,717

Examiner: J. Chapman

Filed: January 3, 2002

Title: Concrete Slab Protector

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APPLICANT'S BRIEF ON APPEAL

Real Party in Interest:

The named inventor for this application, Mark Sanders, is the real party in interest.

Related Appeals

There are no related appeals or interferences for this application.

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Status of the Claims

The application includes 14 claims. Claims 10-14 have been allowed and are not under appeal. Claims 1-4 stand finally rejected under 35 U.S.C. §103 as obvious in view of U.S. Patent No. RE. 29,945 to Scott (the Scott Patent). Claims 5-9 stand finally rejected under 35 U.S.C. §103 as obvious in view of the combination of the Scott Patent with Japanese Reference JP5-71217 (the JP '217 Patent).

Status of Amendments

The claims under appeal have not been amended.

Summary of the Invention

The invention disclosed and claimed in this application under appeal concerns a concrete slab protector that protects a newly poured concrete slab from marring as the slab cures. A primary use for this invention arises where multiple concrete slabs are poured, such as during pouring of a driveway. The concrete slab protector disclosed in this application protects the new concrete while an adjacent slab is treated, such as by floating or troweling to ensure a level concrete surface.

In one embodiment of the invention, as illustrated in FIG. 1 of the application, the concrete slab protector 10 is in the form of a sheet of material having a primary portion 12 that overlies the exposed surface of the newly poured slab S. An overhang portion 14 extends over the edge of the slab and down a portion of the exposed side of the slab. (See, page 6, paragraph 17 of the specification).

The sheet includes a fold line 16 that delineates the primary portion from the overhang portion. The fold line allows the overhang portion to rest flush against the side of the slab while the primary portion rests on the top surface of the slab, as shown in FIG. 1.

In one embodiment, the sheet is provided on a continuous roll, with the fold line scored into the sheet. (See, FIG. 3) The slab protector can then be cut to size at the job site. In another embodiment, the primary portion 12 of the slab protector 10 includes an adhesive strip 18 that can be used to temporarily fix the slab protector to the concrete slab. (See, page 8, paragraph 24 of the specification, and FIG. 2).

Issues on Appeal

1. Whether the Examiner erred in finding claims 1-9 obvious in view of the Scott Patent, whether taken alone or in combination with the JP '217 Patent.
2. Whether the Examiner established a primary case for obviousness of claims 1-9 by basing the rejections on an erroneous reading of the Scott Patent.

Grouping of the Claims

For the purposes of this appeal, the finally rejected claims 1-9 stand or fall together.

ARGUMENT

The Examiner failed to establish a prima facie case for obviousness of Applicant's claims 1-9 because of a faulty interpretation of the primary reference, the Scott Patent. A listing of all the pending claims under appeal is appended to this Brief. Claim 1 is the lone independent claim and is repeated below for reference:

1. A device for protecting at least a portion of a poured slab during activity at a site adjacent the poured slab, said device comprising a sheet including:
 - a primary portion sized to extend substantially along the entire width of the slab to cover a portion of the upper surface of the slab adjacent an exposed side of the slab;
 - an overhang portion sized to cover a portion of the side of the slab; and
 - a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab.

Summary of the Rejections

In rejecting claim 1, the Examiner contended that the Scott Patent disclosed a "multi use concrete form liner with perforations and bends/fold 50/51/52", and that the Scott device included a "primary portion 43/44, and an overhang portion 45-46 and a fold portion 51 connecting the primary portion to the overhang portion". First Office Action, p.2, ¶2. The Examiner also stated that a "fold portion/line 52 enables folding the sheet". First Office Action, p.2, ¶3.

In response to this rejection, Applicant explained that the liner disclosed in Scott did not meet any of the limitations set forth in claim 1 and that the Examiner's interpretation of the Scott Patent was incorrect. In a final action, the Examiner repeated the same language in rendering the obviousness rejection of claims 1-9. Rather than directly address the erroneous understanding of the Scott Patent, the Examiner instead summarily dismissed Applicant's arguments as simply arguing "the purpose and use of his liner verses [sic] those in the prior art". Final Office Action, p.3, ¶4. The Examiner concluded by alleging that,

"Scott clear [sic] shows bends(joint), folds (joint) and perforations; see columns [sic] 7 lines 25-65".

In a Request for Reconsideration, Applicant explained that the prior arguments for patentability did not hinge on a distinction between purpose and use. Instead, the discussion in Applicant's response to the First Office Action was intended to help clarify the true structure of the liner disclosed in the Scott patent. Applicant further explained that the term "joint" in the Scott Patent meant an abutting interface, and not a hinge or fold arrangement. The Examiner did not respond to Applicant's Request for Reconsideration.

Summary of the Scott Patent

The Scott Patent discloses a liner that is mounted on a concrete form, not on the poured concrete itself. See, col. 2, lines 13-15, 20-22, 53-66. The liner panels can include negative surface features that can produce surface details in the finished concrete that contacts the liner panels. See, col. 3, lines 24-29, 37-41.

With the exception of the negative surface features, the liner panels in the Scott Patent are single flat sheets of material. Thus, with reference to FIG. 3, Scott describes four liner panels 43, 44, 45 and 46 that are positioned on three concrete form panels 40, 41 and 42. See, col. 7, lines 26-29. As Scott explains, "the liner panels are arranged in abutting position on the concrete forms with their joints in the middle of the form panel rather than on the joints of the form panel". Col. 7, lines 19-22.

As shown in FIG. 3, a joint 50 between adjacent liner panels 43 and 44 is in the middle of concrete form panel 40. See, col. 7, lines 32-33. The concrete form panel 40 creates a joint 51 between it and the adjacent form panel 41. See, col. 7, lines 33-34. The liner panels 44 and 45 abut at a joint 52 that is also in the middle of concrete form panel 41. See, col. 7, lines 34-36.

Scott explains that the purpose of this offset is that is "provides good backing for the edge abutting joints of the [liner] panels". Col. 7, lines 36-37.

The liner is formed of a sufficiently soft material so that "it squeezes together completely closing the joint and forming a seamless surface of the finished concrete". Col. 7, lines 38-40.

The Examiner's Error in Interpreting the Scott Patent

As indicated above, the Examiner applied the limitations of Applicant's claim 1 as follows:

<u>Claim element</u>	<u>Feature in Scott Patent</u>
a sheet having a primary portion	43, 44
an overhang portion	45, 46
a fold portion	51
(or bends/folds	50, 51, 52)
(or fold portion/line	52)

In matching Applicant's claim elements to the cited Scott features, the Examiner is apparently considering Scott features 43 and 44 to constitute one panel portion, and features 45 and 46 to form a separate panel portion. It is not entirely clear what structure in Scott the Examiner considers to be equivalent to Applicant's claimed fold portion. The Scott features 50, 51 and 52 have been variously identified by the Examiner as a fold. Regardless of which one of the features 50, 51 or 52 the Examiner actually considers to be a fold portion, it is wrong.

The Scott patent identifies four liner panels 43, 44, 45 and 46. See, col. 7, line 29. Scott does not describe any of these four liner panels as being connected in any way. In fact, Scott identifies a joint 50 between the liner panels 43 and 44 which of course can only exist if the two liner panels are separate. Scott also describes a joint 52 between liner panels 44 and 45, again highlighting the separate nature of these panels. The joint between liner panels 45 and 46 is not identified with a feature number in FIG. 4, but the abutting joint between these liner panels is illustrated in the same way as the abutting joints 50 and 52.

Since the form liner panels 43, 44, 45 and 46 in the Scott Patent are independent, they are not connected by any structure. Consequently, the Scott Patent fails to show primary and overhang portions with a fold portion "connecting said primary portion to said overhang portion" as required by Applicant's claim 1.

The Examiner has variously pointed to Scott features 50, 51 and 52 as meeting the fold portion limitation of Applicant's claimed invention. The Scott Patent discloses three concrete form panels 40, 41 and 42. See, col. 7, lines 27-28. Form panels 40 and 41 define a joint 51 therebetween, as depicted by the dashed line in FIG. 4. See, col. 7, lines 33-34. Thus, the feature 51 in FIG. 4 of Scott is not associated with any of the liner panels 43-46. Each liner panel is depicted in FIG. 4 as overlaying a joint between concrete form panels, such as joint 51. It is thus clear that the feature 51 does not connect any of the liner panels 43-46 and does not constitute a fold portion, as required by Applicant's claim 1.

The Examiner also identified the Scott feature 52 as meeting the fold portion limitation of claim 1. However, as explained above, the feature 52 is simply an abutting joint between panels, just like the abutting joint 51 between adjacent concrete form panels. Scott states that the "abutting joints between each of the liner panels are in the middle of the concrete panels". Col. 7, lines 30-31. Scott uses the term "joint" to refer to the abutting relationship between adjacent panels, whether they are the concrete form panels or the inventive liner panels. This use of the term "joint" is consistent with definition provided in the Merriam-Webster Dictionary, namely "an area at which two ends, surface or edges are attached". This dictionary also defines a "butt joint" as "a joint made by fastening the parts together end-to-end without overlap".

When Properly Understood, Claim 1 is Patentable Over Scott

As explained, the Scott Patent fails to disclose every element of Applicant's claim 1. Specifically, Scott does not disclose a connection between two portions of a sheet and does not disclose a fold portion configured so that the

overhang portion can abut an exposed side of a poured concrete slab when the primary portion of the sheet is in contact with the surface of the slab. Thus, the Scott Patent cannot anticipate the claimed invention.

Curiously, the Examiner did not issue an anticipation rejection, even though the Examiner alleged that all elements of Applicant's claims were found in Scott. Nevertheless, Applicant's claimed invention is non-obvious over the Scott Patent, either taken alone or in combination with the JP '217 Patent.

As a preliminary matter, it can be noted that the JP '217 Patent was cited for its disclosure of an adhesive. This reference shows a liner panel similar to that disclosed in Scott, with specific reference to the use of an adhesive in the Abstract. Although it is not explicitly stated in the Abstract, it appears that the liner panel is adhered to a concrete form (see. FIG. 1), and not to the concrete slab, as required by Applicant's dependent claim 5.

The Scott Patent fails to disclose every element of Applicant's claim 1. The Examiner has failed to make out a prima facie case that it would have been obvious to add the missing elements to the liner panels shown in Scott. For that matter, there has been no attempt to make any showing that it would have been obvious to connect two of the Scott liner panels, or that it would have been obvious to introduce a fold portion in any of the liner panels disclosed in the Scott Patent.

To the contrary, a fold portion in any of the liner panels would defeat the purpose of the Scott invention. It is here that a discussion of purpose and use is meaningful. The purpose of the Scott liner panel is to cover the underlying concrete form panel and that has concrete contacting surface features that produce surface patterns in the resulting concrete structure. See, col. 2, lines 4-15, 40-44; col. 8, lines 50-51, 64-68. Scott describes overlapping the concrete form panel joints with the body of a liner panel to provide a good backing for the abutting joints between liner panels. See, col. 7, lines 36-37. Scott also describes squeezing the liner panels together at their abutting joints to close the joint so that the liner panels will produce a "seamless surface of the finished

concrete". Col. 7, lines 37-40. The goal of the Scott liner panel is to eliminate seams of any kind. Adding a fold or a bend to a Scott liner panel will defeat that goal.

Furthermore, the liner panel in the Scott Patent is intended to protect the underlying concrete form panel and not the poured concrete. There is no discussion in Scott of using the liner panels to cover and protect the poured concrete. In fact, Scott discloses that once the concrete is poured, the liner panels are removed with the form panels. See, col. 2, lines 15-20. One object disclosed in Scott is to provide a liner "which does not readily adhere to the concrete". Col. 3, lines 31-32. Consequently, there is no reason to introduce a fold or bend to allow the liner panel to encompass exposed edges of a poured concrete slab.

Conclusion

The Examiner has misconstrued the primary reference used in rejecting claims 1-9 of the present application. The Examiner's interpretation of the Scott Patent as disclosing each element of independent claim 1 is based on a misunderstanding of FIG. 3 of the Scott Patent and the use of the term "joint" in that reference.

The Scott Patent fails to disclose every element of independent claim 1. Most importantly, the Scott Patent neither discloses nor contemplates a fold portion connecting a primary portion and an overhang portion of a slab protector. Moreover, the Scott Patent neither discloses nor suggests providing such a fold portion so that the overhang portion can abut the side of a poured slab while the primary portion is resting on the surface of the slab. Applicant has also demonstrated that there is no suggestion to modify the liner panels disclosed in the Scott Patent to meet the limitations defined in claim 1 of the present application.

Consequently, the Examiner has failed to establish a prima facie case for obviousness with respect to any of the claims of the present application. It is requested that the final rejection of claims 1-9 be reversed and that this Board direct the Examiner to issue a Notice of Allowance with respect to these claims.

Respectfully submitted,



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**APPENDIX
LISTING OF CLAIMS UNDER APPEAL**

1. A device for protecting at least a portion of a poured slab during activity at a site adjacent the poured slab, said device comprising a sheet including:

a primary portion sized to extend substantially along the entire width of the slab and to cover a portion of the upper surface of the slab adjacent an exposed side of the slab;

an overhang portion sized to cover a portion of the side of the slab; and

a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab.

2. The device for protecting a poured slab according to claim 1, wherein said sheet is formed of a flexible material to permit rolling the sheet.

3. The device for protecting a poured slab according to claim 2, wherein said fold portion includes a fold line formed in said sheet to facilitate folding said sheet at said fold portion.

4. The device for protecting a poured slab according to claim 1, wherein said fold portion is formed of a substantially rigid material so that said fold portion maintains said angle when said sheet is not supported on the slab.

5. The device for protecting a poured slab according to claim 1, further comprising means for temporarily adhering at least a portion of said primary portion to the slab.

6. The device for protecting a poured slab according to claim 5, wherein said means for temporarily adhering includes an adhesive strip on said primary portion.

7. The device for protecting a poured slab according to claim 6, wherein said adhesive strip extends around a portion of the perimeter of said primary portion.

8. The device for protecting a poured slab according to claim 6, wherein said adhesive strip extends only along an edge of said primary portion opposite said fold portion.

9. The device for protecting a poured slab according to claim 6, wherein said means for temporarily adhering includes a removable cover at least initially covering said adhesive strip.